

## **REMARKS**

### **I. Request for Withdrawing the Improper Finality of the Office Action**

MPEP 706.07(a) provides: "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." (Emphasis added).

In the First Office Action, the Examiner rejected claims 1-19 for obviousness based on *Hatfield et al.* (Journal of Plastic Film & Sheeting) in view of *Canham et al.* (U.S. Pat. Appl. Pub. No. 20030120001), *Erderly et al.* (U.S. Pat. No. 5,451,450), and Applicant's "Background of Invention." In this Second Office Action, the Examiner concludes that the previous rejections were improper because "the secondary references . . . , at best, cumulative with respect to *Hatfield et al.*" and removes all of these secondary references. *See page 3, the Office Action of September 15, 2006.* The Examiner, however, introduces a new ground of rejection of claims 1-19 which is solely based on *Hatfield et al.* and makes the rejection final. The finality of the second Office Action is premature according to MPEP 706.07(a) because Applicant neither amended the claims nor submitted new IDS during his response to the First Office Action. Therefore, Applicant respectfully requests that the Examiner withdraw the finality of the Second Office Action.

### **II. Claims 1-19 are not Obvious over *Hatfield et al.***

MPEP §2142 provides: *To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine*

*reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).*

First, *Hatfield et al.* cannot make Applicant's claims 1-19 obvious because the reference fails to teach at least two essential claim elements. Claim 1 reads:

**"A method comprising orienting in the machine direction (MD) a polyethylene blown film to a draw-down ratio greater than 10:1 to produce an MD oriented film having a 1% secant MD modulus of 1,000,000 psi or greater." (Emphasis added).**

As the Examiner repeatedly admitted, *Hatfield et al.* not only fails to teach or suggest orienting a polyethylene film in the machine direction at a draw-down ratio greater than 10:1 but also fails to teach or suggest that an MDO method can produce an oriented film having a 1% secant MD modulus of 1,000,000 psi or greater. See page 2, item 1 of the Office Action dated September 15, 2006 and page 2, item 3 of the Office Action dated April 5, 2006.

MPEP §2143.03 provides: *To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).*

According to the instruction of *MPEP* §2143.03, the Examiner fails to establish a prima facie case of obviousness of claim 1 over *Hatfield et al.* because two essential claim elements are missing from the reference. Further, according to the instruction of *MPEP* §2143.03, claims 2-19 cannot be obvious over *Hatfield et al.* because claims 2-19 depend from claim 1.

Second, *Hatfield et al.* cannot make Applicant's claims 1-19 obvious because there is no suggestion or motivation either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. See *MPEP* §2142.

*Hatfield et al.* teaches an MDO (machine direction orientation) method. More particularly, *Hatfield et al.* teaches the use of a process aid (a long chain carboxylic acid) to increase the draw ratio of a MMW-HDPE (medium molecular weight, high density polyethylene) film during MDO. According to *Hatfield et al.*, the process aid is used because "[m]any HDPEs need to be drawn at relatively high draw ratios before they orient evenly without stretch resonance." See reference page 118, the second last sentence of third paragraph.

With the process aid, *Hatfield et al.* achieved a maximum draw ratio of only 8:1 and maximum 1% secant MD modulus of 401,620 psi. See reference Table 2, page 122. *Hatfield et al.* explains why a higher draw ratio cannot be usually reached: "The problem is that the film typically breaks while passing through the stretch resonance region before reaching these draw ratios or the film will not orient at the high draw ratio." See reference page 118, the last sentence of third paragraph.

Contrary to the Examiner's obviousness assertion, Applicant finds no teaching or suggestion from *Hatfield et al.* which would motivate a person of ordinary skill in the art to orient a polyethylene blown film at a draw ration beyond 8:1 and to make an MDO film have a 1% secant MD modulus greater than

1,000,000. Instead, as discussed above, *Hatfield et al.* suggests that orienting the film beyond 8:1 draw ratio would be extremely difficult.

*MPEP §2143.01 provides: In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).*

As discussed above, there is no teaching in *Hatfield et al.* which "would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." See *MPEP§2143.01*. Hence, *Hatfield et al.* cannot make claims 1-19 obvious.

Applicant respectfully requests that the Examiner withdraw the rejections and allow remaining claims 1-19. Applicant invites the Examiner to telephone his attorney, Shao-Hua Guo, at (610) 359-2455 if a discussion of the application might be helpful.

Respectfully submitted,

D. Ryan Breese

By: 

Shao-Hua Guo  
Attorney for Applicant  
Reg. No. 44,728  
Lyondell Chemical Company  
Phone: (610) 359-2455  
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